

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Art Unit: 1642
ANDERSEN, et al.)) Examiner: YU, M.
Serial No.: 10/580,016)) Washington, D.C.
Filed: February 28, 2007)) October 1, 2009
For: PROTEINS BELONGING TO THE) Docket No.: ANDERSEN=8
BCL-2 FAMILY AND)
FRAGMENTS THEREOF, . . .) Confirmation No.: 7719

ELECTION WITH TRAVERSE

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S i r :

1. In response to the restriction requirement mailed July 7, 2009, applicants elect group I with traverse. It is noted that the examiner defines group I as claims 1-65, but 53 was cancelled by the February 28, 2007 preliminary amendment.

2. The Examiner has plainly erred by applying US domestic restriction practice to a PCT national stage case. Thus, the restriction between invention I and inventions II, V and VI is based on the domestic provision MPEP 806.05(h), relating to a claimed product with a different utility than the claimed method.

Under PCT practice, restriction between product and method of use is proper only if the product is shown to be *prima facie* lacking in novelty or nonobviousness. See PCT Administrative Instructions, Annex B, paragraph (e)(i).

Inventions III, IV and VI are said to be "unrelated". I assume the examiner means, unrelated to invention I, because by saying that claims 67 and 70 link III with IV, these are conceded to be related to each other.

Group I is to a vaccine composition which may comprise a

peptide fragment and groups III and IV are directed to an antibody (III) or T-cell receptor (IV) which specifically binds such fragment. This would seem to give them "corresponding features", like the socket and plug of PCT International Search and Preliminary Examination Guidelines 10.28 example 8 or the transmitter and receiver of Guidelines 10.29 example 9, or the DNA and the encoded protein of Guidelines 10.59 Example 39.

Group VI is directed to a method of monitoring which comprises evaluating whether protein or peptide fragment antigen (per group I) bond by antibodies (III) is T-cell receptors (IV) in a patient's blood sample. It is thus a use of a component of the vaccine of group I. There thus appears to be a "relationship" with group I, albeit not a simple product/method-of-use relationship.

3. In response to the species restrictions set forth at the bottom of page 5, applicants make the following elections, all with traverse:

- #1) peptide
- #2) Bcl-2
- #3) HLA-A2

Re species election #1: All group I claims except 50-52 and 54-57 are plainly generic to or otherwise cover the elected "peptide".

Group I claims 50-52 require that the vaccine comprise antigen-presenting cells, but these cells may still comprise the elected peptide and hence we submit they should still be examined.

Group I claims 54-57 limit the nucleic acid of claim 1, but do not require that the vaccine composition comprise nucleic acid, and hence we submit they should still be examined.

Re species election #2: All group I claims except 6, 8, 9,

12, 14, 15, 46, and 47 are plainly generic to or otherwise cover the elected protein Bcl-2.

Re species election #3: All group I claims are plainly generic to or otherwise cover the elected haplotype HLA-A2.

Hence, if all restrictions are maintained, the claims to be examined are 1-5, 7, 10, 11, 13, 16-45, 48, 49, 58-65 and possibly 50-52 and 54-57.

4. The species restriction is procedurally improper because under PCT unity practice, there must be a holding of a posteriori lack of unity (based on a cited reference) before restriction. This differs from domestic unity practice, in which species restrictions are used to limit the field of search and hence made before finding prior art.

With regard to species requirement #1, the APC species are related, as combination/subcombination, to the corresponding protein or peptide or nucleic acid species, and hence, under domestic practice, restriction is proper only if the conditions for combination/subcombination are met. See MPEP 808.01(a), para. 2, MPEP 806.04(b), para. 1, and MPEP 806.05(c)(I). PCT practice is similar, see PCT Administrative Instructions, paragraph 3(c)(i).

Likewise, there is a combination/subcombination relationship between a protein and its peptide fragment. Hence, we respectfully urge joinder of peptide, protein, and APCs presenting a peptide or protein.

With regard to species requirement #2, the choices appear to be derived from claims 5, 6, and 23. Since the sequences of claim 23 are fragments of the proteins of claims 5 and 6, combination/subcombination practice is applicable here, too.

5. Above and beyond the foregoing, we remind the examiner that under MPEP 821.04, cited at pp. 7-8, if product claims such as the elected group I claims are deemed allowable, all dependent

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method-of-making and method of use claims are rejoined. This would in particular include the group V claims 71-75.

Respectfully submitted,

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